

No. 21,124

United States Court of Appeals
For the Ninth Circuit

ROSA CONTINENTE, dba G. CONTINENTE, <i>Plaintiff-Appellant,</i>	}
VS.	
JOHN A. CONTINENTE, <i>Defendant-Appellee.</i>	

PLAINTIFF-APPELLANT'S REPLY BRIEF

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PLAINTIFF-APPELLANT'S REPLY BRIEF

Plaintiff submits this reply to certain points which are raised in the Brief for Defendant-Appellee.

A. LIKELIHOOD OF CONFUSION

As to likelihood of confusion, irrespective of the views of the 5th Circuit, as expressed in the decisions cited in defendant's brief, this court has adopted the more widely held view that "we are in as good a position as the trial judge to determine the probability of confusion". *Sleeper Lounge Company v. Bell Manufacturing Co.*, 253 F.2d 720 (9th Cir. 1958); *The Fleischmann Distilling Corporation, et al. v. Maier Brewing Company, et al.*, 314 F.2d 149 (9th Cir. 1963).

The quoted and approved language was taken by this circuit from *Miles Shoes, Inc. v. R. H. Macy & Co.*, 199 F.2d 602 (2nd Cir. 1952).

The defendant contends in his brief that he never used the name "CONTINENTE" alone. Defendant's original labels, as shown in plaintiff's exhibit 34, as originally printed and applied to the grape lug boxes, admittedly consisted of the word "CONTINENTE" alone; but were later allegedly modified by the addition of rubber stamping "JOHN A." on such labels before the grapes were shipped in commerce. Plaintiff has no assurance that defendant will not in the future again print plain "CONTINENTE" labels, and ship his grapes as such.

The defendant further contends that plaintiff's grapes have always been marketed under a label showing "CONTINENTE BRAND" with the picture of a small girl, as indicated in plaintiff's exhibit 5. It is submitted, however, that plaintiff also uses her registered CONTINENTE mark without such a picture, as is clear from the side imprints or inserts found in plaintiff's exhibits 7 and 8. The various auction reports concerning the sale of plaintiff's CONTINENTE grapes and which are posted at the auctions (Tr. 106-107), likewise do not include any such picture; nor does plaintiff's registration (plaintiff's exhibits 1 and 3) which is directed to the word "CONTINENTE" alone.

While plaintiff may have used a broker in New York City, auctions of plaintiff's grapes take place in Jersey City (Tr. 95) and purchasers come from

Boston and all over the country (Tr. 96). Also, when jobbers contact plaintiff by phone for "CONTINENTE" grapes (Tr. 75-76), no picture is present.

The real issue thus remains as to whether "JOHN A. CONTINENTE", when used in a trademark sense, and which in at least one established situation was abbreviated by a third party to "J. CONTINENTE", is confusingly similar to the registered mark "CONTINENTE" for the identical product, namely juice grapes, when each product is grown and shipped from the identical geographical area. This should be answered in the affirmative.

This is not a case of two independent firms doing business under similar marks or names in separate and distinct geographical areas, such as in *Dawn Donut Co., Inc. v. Hart's Food Stores, Inc., et al.*, 267 F.2d 358 (2nd Cir. 1959), strongly relied upon by defendant herein. Here, plaintiff and defendant are doing business literally next door to each other, i.e., in the same identical market. The fact that some of the ultimate purchasers of the respective products may be geographically separated does not alter the fact that the defendant uses his confusingly similar and infringing mark in the identical area wherein plaintiff's registered mark is used.

B. THE EFFECT OF PLAINTIFF'S INCONTESTIBLE REGISTRATION

For the reasons and under the authority set forth in plaintiff's opening brief, plaintiff may properly rely upon her rights under her registration.

In *Tillamook County Creamery Association v. Tillamook Cheese and Dairy Association*, 345 F.2d 158 (9th Cir. 1965), cited by defendant in attempting to refute plaintiff's position, the situation was entirely different from the case at bar wherein defendant is a "Johnny-come-lately" in his usage of the infringing mark. In *Tillamook*, both the trial court and the appellate court found and held that it was the defendant who first adopted and used the trademark in question. Under such circumstances the plaintiff's subsequent use and registration could not operate to deprive the defendant of its prior rights.

Defendant also cites *Blanchard & Co., et al. v. Charles Gilman & Son, Inc., et al.*, 239 F.Supp. 827 (D. Mass. 1965), which is not pertinent to the facts of this case, since in *Blanchard*, the registrant apparently failed to file under the provisions of U. S. Code, Title 15, Section 1052 (f) which provides for registration of surnames, and under which plaintiff herein procured her registration.

Defendant also attacks plaintiff's registration on the grounds of alleged wrongful conduct in procuring and/or maintaining the same. The court below found no such wrongful conduct, and no appeal was taken by defendant as to the finding of validity of the registration in suit (R. 99). The most that can be made out of

defendant's contentions is that the application as filed erroneously listed additional products to grapes. If the Patent Office granted registration on *all* of such goods, it obviously would have granted it on fewer goods, or on grapes alone. When the error was called to plaintiff's attention, the registration was promptly rectified in accordance with the provisions of the Lanham Act (plaintiff's exhibit 4), and the amended registration (plaintiff's exhibit 3) was duly and regularly issued.

No question has been raised, nor could be raised as to plaintiff's long and continuous use of her mark on grapes, and it is the defendant's use of his mark on precisely the same goods of which complaint is made.

The burden is on defendant to establish fraud, and this was not done in the court below. *Apple Growers Assn. v. Pelletti Fruit Co.*, 153 F.Supp. 948 (N.D., Cal. 1957).

In *The Reese Chemical Co. v. Lisner*, 87 USPQ 121 (Comm. Pat. 1950), cited by defendant, a mere administrative ruling by the Patent Office was made concerning a registration wherein the registrant had *not* requested restriction of his registration to the goods on which he had in fact used his mark. The Patent Office refused to make such a restriction on its own. This is contrary to the facts herein, wherein such request was made by the plaintiff and granted by the Patent Office.

C. THE PURPORTED "SACRED" RIGHT OF DEFENDANT TO USE HIS NAME

The defendant's brief quotes from page 192 of Nims Unfair Competition and Trade-Marks, 4th Edition (1947) Vol. 1, that "Every man has a right to the use of his own name. That is the first principle." The defendant failed to quote the next sentence, which reads:

"To this the law of unfair competition gradually is adding another—no man may use even his own name in such manner as to injure another unfairly or fraudulently in his business."

Plaintiff herein is not attempting to deprive the defendant from using his own name. He may use his name in all his personal, social and business dealings, other than as an infringing trademark of which complaint is made herein. When using even his own name as a trademark for grapes, defendant is using his name unfairly and in derogation of plaintiff's rights.

If defendant's position was legally sound there would be no benefit whatsoever in the registration of a surname, permitted under the Lanham Act, 15 U. S. Code, Title 15, Section 1052 (f) if every other person having such a surname could use it as a trademark.

The cases cited by defendant are not pertinent to the issues herein.

In *John P. Dant Distillery Co. v. Schenley Distillers, Inc.*, 189 F.Supp. 821, 128 USPQ 456 (W.D. Ky. 1960), plaintiff and defendant had each used their respective marks for over 50 years without complaint, and it was held to be unequitable to complain at such a late date. In the case at bar, written complaint was

made before defendant made his first shipment (plaintiff's exhibit 39).

In *D & W Food Corp. et al. v. Graham*, 286 P.2d 55 (Cal. D. C. of A. 1955) the situation involved the use of a common law trade *name*, not a federally registered trade *mark* and its effect.

In *Crane Co. v. Crane Heating & Air Conditioning Co., et al.*, 299 F.2d 577 (6th Cir. 1962), defendant's use of their surname was as a trade *name* and not as a trade *mark*. Furthermore, plaintiff had known of defendant's use and had actually encouraged such use; and others had used "Crane" as a trade name for over 50 years. No such factors are present here.

For the reasons stated, plaintiff-appellant urges that the judgment of the District Court be reversed.

Dated, Oakland, California,
February 24, 1967.

Respectfully submitted,

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Plaintiff-Appellant.

CERTIFICATE OF COUNSEL

I certify that, in connection with the preparation of this brief, I have examined Rules 18, 19 and 39 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

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